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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CATHERINE LIN-HENDEL

Appeal 2008-0480
Application 09/544,036
Technology Center 2100

Decided: November 18, 2008

Before LANCE LEONARD BARRY, ALLEN R. MACDONALD, and
JAY P. LUCAS, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1-49. The Appellant appeals therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

A. INVENTION

The invention at issue on appeal allows a user to select plural link-tokens shown in a web page. The invention then retrieves and simultaneously presents objects associated with the selected tokens in a single window. (Preliminary Amendment 16.)

B. ILLUSTRATIVE CLAIM

Claim 32, which further illustrates the invention, follows.

32. A system for displaying content viewed on a display device, comprising:

a single electronic webpage displaying simultaneously together a plurality of scrolling sub-framed arrays, each sub-framed array containing a frame containing a plurality of thumbnails and a plurality of independently selectable sub-frames, each sub-framed array able to be independently and selectively stopped and scrolled at a selective speed by a viewer or website operator.

C. REFERENCES

The Examiner relies on the following references as evidence:

Tang	US 5,793,365	Aug. 11, 1998
Itoh	US 5,966,122	Oct. 12, 1999
Collins-Rector	US 6,188,398 B1	Feb. 13, 2001 (filed Jun. 2, 1999)

Gilman	US 6,208,770 B1	Mar. 27, 2001 (filed Sep. 18, 1998)
Himmel	US 6,211,874 B1	Apr. 3, 2001 (filed May 15, 1998)
Kaply	US 6,215,490 B1	Apr. 10, 2001 (filed Feb. 2, 1998)
Gibson	US 6,313,854 B1	Nov. 6, 2001 (filed Oct. 16, 1998)
Moore	US 6,330,575 B1	Dec. 11, 2001 (filed Mar. 31, 1998)
Iyengar	US 6,360,205 B1	Mar. 19, 2002 (filed Oct. 30, 1998)

D. REJECTIONS

Claims 1, 7, 8, 12-24, 26, 27, 29, 31, 48, and 49 stand rejected under 35 U.S.C. § 103(a) as obvious over Himmel and Gibson.

Claims 2-5, 32-34, and 40-43 stand rejected under 35 U.S.C. § 103(a) as obvious over Himmel, Gibson, and Kaply.

Claim 6 stands rejected under 35 U.S.C. § 103(a) as obvious over Himmel, Gibson, Kaply, and Gilman.

Claims 9-11 and 28 stand rejected under 35 U.S.C. § 103(a) as obvious over Himmel, Gibson, and Iyengar.

Claims 25 and 30 stand rejected under 35 U.S.C. § 103(a) as obvious over Himmel, Gibson, and the Appellant's admitted prior art ("AAPA").

Claim 35 stands rejected under 35 U.S.C. § 103(a) as obvious over Himmel, Gibson, Kaply, and Gavron.

Claim 36 stands rejected under 35 U.S.C. § 103(a) as being obvious over Himmel, Gibson, Kaply, and Tang.

Claims 37-39 stand rejected under 35 U.S.C. § 103(a) as being obvious over Himmel, Gibson, Kaply, and Itoh,

Claim 44 stands rejected under 35 U.S.C. § 103(a) as being obvious over Himmel, Gibson, Kaply, and Moore.

Claim 45 stands rejected under 35 U.S.C. § 103(a) as being obvious over Himmel, Gibson, Kaply, and Collins-Rector.

Claim 46 stands rejected under 35 U.S.C. § 103(a) as being obvious over Himmel, Gibson, Kaply, and AAPA.

Claim 47 stands rejected under 35 U.S.C. § 103(a) as being obvious over Himmel, Gibson, Kaply, AAPA, and Iyengar.

II. PROCEDURAL DEFECTS

When the Appellant filed her Appeal Brief, it was required to include "[a] concise explanation of the invention defined in the claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters." 37 C.F.R. § 1.192(c)(5)(2006).¹ Reference to page and line number of the Specification "is considered important to enable the Board to more quickly determine where the claimed subject matter is described in the application." MPEP § 1205.02 (8th ed., 5th rev., Aug. 2006).² "Because it enables the Board to more quickly determine where the claimed subject matter is described in a patent application, reference to such characters is always important." *Ex parte Nelson*, No. 2007-3534, 2008 WL 1957935 (BPAI 2008).

¹ We cite to the version of the Code of Federal Regulations in effect when the Appellant filed the Appeal Brief. The current version includes the same rules.

² We cite to the version of the Manual of Patent Examining Procedure in effect when the Appellant filed the Appeal Brief. The current version includes the same provisions.

Here, the Appellant replaced almost all of the original Specification with extensively rewritten paragraphs. (Preliminary Amendment 1-79.) The Appeal Brief, however, includes a *Summary of Claimed Subject Matter* that references her *original* Specification by page and line number. (Br. 7-11.) Because almost all of the original Specification has been deleted and replaced, the references to the original Specification are invalid.

The Appellant also replaced the original Figures 1 and 9-14 with thirty-four new drawings, viz., "new FIGS. 1 and 9A-14-L." (Preliminary Amendment 42.) The *Summary's* explanation of claim 32, however, references the original "Fig. 14" (Appeal Br. 10). Because Figure 14 has been deleted and replaced with Figures 14A to 14L, the reference is invalid.

Furthermore, although the *Summary's* explanation of claims 27, 32, and 48 also includes helpful references to the Appellant's drawings (*id.* 8-11), its explanation of claim 1 (*id.* 7-8), however, omits reference to any of the 79 drawings.

Rather than enabling the Board to more quickly determine where the claimed subject matter is described in the application, the invalid references and omissions impeded our efforts to do so. The Appellant should ensure that future summaries of claimed subject matter map each limitation of independent and separately argued claims to valid Specifications by page and line number and to the valid drawings by reference characters.

III. CLAIMS 1-31, 48, AND 49

"Rather than reiterate the positions of the parties *in toto*, we focus on an issue therebetween." *Ex parte Kuruoglu*, No. 2007-0666, 2007 WL 2745820, at *2 (BPAI 2007). The Examiner admits that "Himmel fails to clearly disclose the feature of 'the plurality of stored objects displayed within a single window for viewing'." (Answer 29.) He finds, however, that "Gibson teaches a plurality of stored window objects 112a, 112b and 112c being displayed within a single window 114 (Gibson, figure 6)." (*Id.*) The Appellant argues that "Gibson's child windows shown in Figure 6 are . . . defined by a web page, not selected by the user from the web page." (Reply Br. 11.)

A. ISSUE

Therefore, the issue is whether the Examiner has shown that the combined teachings of Himmel and Gibson would have suggested retrieving a plurality of objects respectively linked to a plurality of selected objects and simultaneously displaying together the linked objects within a single viewing window.

B. PRINCIPLES OF LAW

"In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992)). "A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have

suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 991 F.2d 781, 783 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051 (CCPA 1976)).

C. FINDINGS OF FACT

Himmel's "FIG. 5B depicts the selection of three links: 'hypertext link 2' 112a, 'hypertext link 4' 112b, and 'hypertext link 5' 112c." (Col. 7, ll. 18-20.) "When the user then hits the 'Enter' key," (*id.* ll. 25-26), the reference retrieves the web pages respectively linked to the hypertext links and simultaneously displays the web pages. The web pages, however, are not displayed together within the same, single viewing window. Instead, "**three** new windows 114a, 114b and 114c appear as shown in FIG. 5C, which retrieve the pages (entitled 'LINK 2,' 'LINK 4,' and LINK 5') respectively associated with links 112a, 112b and 112c." (*Id.* ll. 26-29 (emphasis added).)

For its part, Gibson discloses "[a] method of accessing an electronic page on a computer system, by ascertaining that the electronic page is adapted to be displayed as a single window containing a plurality of frames (having fixed attributes), but then displaying separate windows for respective frames" (Abs. ll. 1-5.) The Figure on which the Examiner relies "is a pictorial representation of the creation of multiple child windows in a web browser wherein each child window corresponds to a respective frame defined by a web page" (Col. 5, ll. 45-48.) Gibson includes the following description of the example shown in Figure 6.

In this example, a web page 110 resides at a remote server (not shown) in the form of a main HTML file which uses appropriate tags to create three frames 112a, 112b and 112c. The page as it is intended to be displayed by the page creator (with three frames) is shown at the top of FIG. 6 in dashed lines. When the browser software retrieves page 110, it ascertains that the page is intended to be displayed with frames by interpreting the HTML tags, but it instead presents each frame as a separate window with its own controls to enable one or more window operations that otherwise would not be available to the frames. The displayed page 110' thus has three child windows 112a', 112b' and 112c' corresponding to the three frames 112a, 112b and 112c, respectively.

(Col. 8, ll. 13-26.)

D. ANALYSIS

When the aforementioned teachings of Himmel and Gibson were combined, we are unpersuaded that the combination would have displayed web page LINK 2, web page LINK 4, and web page LINK 5 within a single viewing window. Instead, we find that the teachings would still have displayed the three web pages in the three separate windows 114a, 114b, and 114c shown in Figure 5C of Himmel. The added teachings from Gibson, however, would have ascertained whether any of the three web pages contained plural frames. If so, the added teachings would then have displayed separate windows for each of these frames.

The Examiner does not allege, let alone show, that the addition of Kaply, Gilman, Iyengar, or AAPA cures the aforementioned deficiency of Himmel and Gibson.

E. CONCLUSION

For the aforementioned reasons, the Examiner has not shown that the combined teachings of Himmel and Gibson would have suggested retrieving a plurality of objects respectively linked to a plurality of selected objects and simultaneously displaying together the linked objects within a single viewing window.

IV. CLAIMS 32-43 AND 45-47

When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately.

37 C.F.R. § 41.37(c)(1)(vii).

Here, the Appellant argues claims 32-34 and 40-43, which are subject to the same ground of rejection, as a group. (App. Br. 26-27.) Therefore, we select claim 32 as the sole claim on which to decide the appeal of the group.

A. ISSUE

The Examiner makes the following findings and conclusion.

It would have been obvious to an artisan at the time of the invention to use the teaching from Gibson of displaying a

plurality of scrolling sub-framed arrays displayed within a single electronic webpage since users can more effectively manipulate and manage the viewable area of the browser while preserving the advantages of frames.

(Ans. 10.)

The Appellant argues "that this rationale is impermissibly based on Applicant's disclosure, for no other source was given" (App. Br. 25.) She further argues that "[i]n discussing . . . disadvantages of having frames within a displayed webpage, Gibson apparently teaches away from displaying multiple sub-frames in a webpage window" (*Id.* 26.) Therefore, the issue is whether the Appellant has shown error in the Examiner's reason for combining teachings from Himmel and Gibson.

B. PRINCIPLES OF LAW

"Any judgment on obviousness is . . . necessarily a reconstruction based on hindsight reasoning, but so long as only knowledge which was within the level of ordinary skill at the time the claimed invention was made and does not include knowledge gleaned from applicant's disclosure, such a reconstruction is proper." *In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971). *See also Radix Corp. v. Samuels*, 13 USPQ2d 1689, 1693 (D.D.C. 1989) ("[A]ny obviousness inquiry necessarily involves some hindsight."). A reason to combine teachings from the prior art "may be found in explicit or implicit teachings within the references themselves, from the ordinary knowledge of those skilled in the art, or from the nature of the problem to be solved." *WMS Gaming Inc. v. Int'l Game Tech.*, 184 F.3d 1339, 1355 (Fed. Cir. 1999) (citing *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

"What the prior art teaches and whether it teaches toward or away from the claimed invention . . . is a determination of fact." *Para-Ordnance Mfg., Inc. v. SGS Importers Int'l, Inc.*, 73 F.3d 1085, 1088 (Fed. Cir. 1995). "All of the disclosures in a reference must be evaluated for what they fairly teach one of ordinary skill in the art." *In re Boe*, 355 F.2d 961, 965 (CCPA 1966)). "[I]n a section 103 inquiry, 'the fact that a specific [embodiment] is taught to be preferred is not controlling, since all disclosures of the prior art, including unpreferred embodiments, must be considered.'" *Merck & Co. Inc., v. Biocraft Labs., Inc.*, 874 F.2d 804, 807 (Fed.Cir.1989) (quoting *In re Lamberti*, 545 F.2d 747, 750 (CCPA 1976)). "[T]he prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternative because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed . . ." *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004).

C. FINDING OF FACT

The reason given by the Examiner for combining teachings from Himmel and Gibson is that "users can more effectively manipulate and manage the viewable area of the browser while preserving the advantages of frames." (Answer 10.)

D. ANALYSIS

We conclude that such a reason would have been within the level of ordinary skill at the time the claimed invention was made. The Appellant,

moreover, has not shown that the reason is based on knowledge gleaned **only** from her disclosure.

The Appellant quotes one paragraph and a fraction of another paragraph from Gibson to support her argument that the reference "teaches away from displaying multiple sub-frames in a webpage window" (App. Br. 26) We agree that one paragraph "discuss[es] . . . disadvantages of having frames within a displayed webpage" (*Id.*) The rest of the other paragraph, however, discusses "advantages of frames which may be desirable to some extent." (Col. 4, ll. 32-33.)

The mere disclosure of advantages and disadvantages of having frames within a displayed webpage does not criticize, discredit, or otherwise discourage the use thereof and, therefore, does not constitute a teaching away therefrom. Rather than arguing the rejection of claims 35-39 and 45-47 separately, the Appellant relies on the aforementioned arguments. (App. Br. 29-31.)

E. CONCLUSION

For the aforementioned reason, the Appellant has shown no error in the Examiner's reason for combining teachings from Himmel and Gibson.

V. CLAIM 44

The Examiner makes the following findings and conclusion. "It would have been obvious to an artisan at the time of the invention to use the

teaching from Moore of including transactional commands to process a commercial transaction since it would allow the user to process the commercial transaction immediately after viewing an interested thumbnail." (Ans. 19.) The Appellant argues that the Examiner "did not cite any specific prior art that teaches this motivation." (App. Br. 30.)

A. ISSUE

Therefore, the issue is whether the Appellant has shown error in the Examiner's reason for combining teachings from Moore.

B. PRINCIPLES OF LAW

The presence or absence of a reason "to combine references in an obviousness determination is a pure question of fact." *In re Gartside*, 203 F.3d 1305, 1316 (Fed. Cir. 2000) (citing *In re Dembiczak*, 175 F.3d 994, 1000 (Fed. Cir. 1999)). "The obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation, or by overemphasis on the importance of published articles and the explicit content of issued patents. The diversity of inventive pursuits and of modern technology counsels against limiting the analysis in this way." *KSR Int'l v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007).

C. FINDING OF FACT

The reason given by the Examiner for combining teachings from Moore is to "allow the user to process the commercial transaction immediately after viewing an interested thumbnail." (Ans. 19.)

D. ANALYSIS

We conclude that such a reason would have been within the level of ordinary skill at the time the claimed invention was made. The Appellant's argument that a reason to combine teachings from the references must be taught by specific prior art, moreover, is incorrect.

E. CONCLUSION

For the aforementioned reason, the Appellant has shown no error in the Examiner's reason for combining teachings from Moore.

VI. ORDER

We reverse the rejections of claims 1-31, 48, and 49 but affirm the rejections of claims 32-47.

No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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